REMARKS

Present Status of Application

After entry of the foregoing amendments, claims 1, 3-4, and 6-9 remain pending in the application. The Office Action rejected all claims under 35 U.S.C 103(a) as allegedly unpatentable over Chui et al (U.S. Patent 6,389,160) in view of Huang (U.S. Patent 6,173,079). Reconsideration of these claims is respectfully requested in light of the foregoing amendments in view of the following remarks.

Fundamental Distinction between the Cited Art and the Pending Claims

Applicant respectfully traverses the rejections of claims 1-9 of the present application for reasons that will be specifically addressed in following paragraphs. However, before addressing the details of specific rejections, Applicant notes that there are fundamental differences between the apparatus and method of Chui and Hwang and that of the pending claims. The pending claims are directed to an image processing device that the size of the eliminated part of the image data files is equally divided among the compressed image data files stored in the memory device. The present claims, as amended, define the creation of storage space **by equally eliminating the end portion of the compressed image data files stored in the memory device**.

In contrast, Chui discloses a method of encoding image data, compressing an image file with a compression ratio, but does not disclose the storage space used in the memory device and the size of the compressed image data file. Further, Hwang focuses on producing and comparing an estimate of an amount of data to be accumulated for an image file once a time, but does not disclose technical features described in the present invention that the eliminated parts are equally shared among the compressed image data files stored in the memory device.

Thus, the method applied by Chui and Hwang and that defined in the device of the present claims are notably different.

Rejection of Claims 1-9

The Office Action tentatively rejected claims 1-9 under 35 U.S.C 103(a) as allegedly unpatentable over Chui et al and Huang. Independent claims 1 and 3 are amended to overcome the rejection(s) under 35 U.S.C. 103(a) Applicant respectfully traverses these rejections made by the Examiner for at least the following reasons.

As described above, the Office Action alleges that Chui et al teaches an image processing device architecture comprising a compressing device, a memory device, a decompressing device, and a processing device, as the device architecture defined in the present claims. Applicant notes that the device architecture for the disclosed method in Chui is different from that of the pending claims. The image data processing method defined by the present claims is not disclosed in the Chui citation.

Further, the Office Action alleges that Hwang teaches a buffer data control method in an image compression system and discloses the storage space used in the memory device and the size of the compressed image data file. Applicant, however, notes that the compression system does not disclose the technical features defined in the pending claims; namely, that the eliminated parts are equally shared among the compressed image data files stored in the memory device.

For at least the foregoing reasons, Applicant respectfully submits that all pending claims define over the cited art, as the cited art (taken in combination) fails to disclose all claimed features.

As a separate and independent basis for the patentability of the pending claims, Applicant respectfully submits that there is no proper motivation for combining the teachings of Chui and Hwang. In this regard, the Office Action alleges only that the combination would have been obvious because "this feature is very conventional providing a user with additional memory space..." Applicant traverses this motivation is being insufficient under the long-standing legal requirements of 35 U.S.C. § 103.

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. §103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

> "The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, the Applicant note that there must not only be a suggestion to broaden the functional or operational aspects of the cited reference, but that the Federal Circuit also requires the prior art to suggest the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection, the prior art must properly suggest the desirability of providing the apparatus, as claimed by the Applicant. "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the

claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

"A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed.Cir.2000)) (*quoting C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998)); The Federal Circuit has made it clear "that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir.1999).

Simply stated, the rejection under 35 U.S.C. § 103 set forth by the Examiner fails to satisfy these fundamental legal requisites, and the rejections under 35 U.S.C. § 103 should be overturned.

As mentioned, the present invention differs significantly from the Chui and Hwang references. None of the cited references, when taken alone or in combination, teaches all of the limitations recited in amended claims 1 or 3 of the present application. Thus, these claims are allowable over the cited references. Insofar as claims 4 and 6-9, depend from claim 3, these claims are similarly patentable over the cited references.

Cited Art of Record

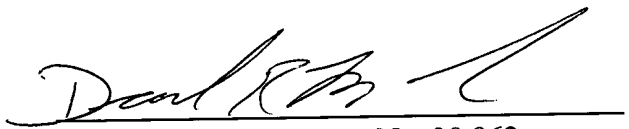
The cited art of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,



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